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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,165	01/29/2002	Martin Caldwell	741890-0023	4375
22204	7590	11/14/2005		
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER EREZO, DARWIN P	
			ART UNIT 3731	PAPER NUMBER

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/048,165

Applicant(s)

CALDWELL ET AL.

Examiner

Darwin P. Erez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 27-37 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8, 10-12 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,556,411 to Taoda et al.

As to claim 1, Taoda discloses a surgical device, as shown in Fig. 1, which includes a cannula **2** defining a conduit and having a distal ring **22**; a trocar assembly **(3,4)** carried on the inner surface of the cannula; and a fixing means **5** capable of locking the cannula in position on the patient's body during surgery; wherein the trocar is removably attached to the cannula via short threads **(25,45)** thereby fully allowing the trocar to be inserted into a body cavity and to pierce tissue with a cutting element **31** without escape of gas since the outer diameter of the trocar is substantially the same as the inner diameter of the cannula.

Taoda also teaches the trocar having an extension shoulder **42**; wherein the trocar incorporates a guard means/sheath **4**; wherein the cannula incorporates means for releasably attaching the cannula to an interior of the body cavity via tapered end portion **22**, which can be referred to as an internal ring; wherein the fixing means is an anchor ring **5**; wherein the anchor ring uses the same thread as the trocar assembly

(embodiment shown in Fig. 2; the trocar assembly including elements 3 and 6); wherein the cannula includes an insufflation port (the channel of the cannula).

Taoda also teaches the anchor ring fully capable of performing as a manual valve, wherein tightening the anchor ring will prevent any fluid flow and wherein loosening the anchor ring will allow fluid to flow between the tissue and cannula. It should be noted that the applicant has not claimed any specific structural element for the "valve".

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 13-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taoda et al. and in view of US 5,743,881 to Demco.

As to claims 9 and 25, Taoda teaches all the limitations of the claim except for the cannula having a valve.

However, Demco teaches a similar cannula/trocar assembly, wherein the cannula includes a diaphragm valve **22** to prevent air from passing through when an instrument is removed from within the cannula (col. 4, lines 44-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cannula of Taoda to include a valve system,

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as taught by Demco, because it allows instruments to be used within the cannula but prevents the leakage of gas/air in the absence of said instruments.

As to claim 13, the end portion **22** is fully capable of functioning as an external seal and the combination of Taoda/Demco teaches the internal valve, as recited above.

As to claim 14, the above combination will teach an integrally formed seal and valve.

As to claim 15, the trocar assembly of Taoda is fully capable of engaging both the valve and the end portion **22**.

As to claims 16-18, the modification of the cannula of Taoda to include the valve means of Demco will have the valve means located at the end portion **22** (seal housing), wherein the tapered end portion is viewed as an extended entry port and wherein the entry port is conical (cylindrical tapering).

As to claims 19-21, Taoda teaches all the limitations of the claims except for an insufflation lumen located at an exterior of the cannula. However, Demco teaches a well known cannula having an insufflation port **24** having a lumen located at the exterior of the cannula. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cannula of Taoda to include the insufflation port of Demco having a lumen because it allows the introduction of fluids into the cannula without necessitating the removal of an attached instrument, such as the trocar assembly.

As to claims 22-23, the fixing means **5** and the distal ring **22** are fully capable of performing as cushions, especially in the absence of any specific structure for the claimed "cushion" element.

As to claim 24, element 6, which is part of the trocar assembly shown in Fig. 2, provides a surgeon a place to hold during insertion of the surgical device.

Allowable Subject Matter

5. Claim 26 is allowed.

Response to Arguments

6. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

7. It should be noted that claims 1-25 are directed towards a device claim.

Therefore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who's telephone number is (571) 272-4695. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan T. Nguyen can be reached on (571) 272-4963. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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GLENN K. DAWSON
PRIMARY EXAMINER